

Remarks

Reconsideration is requested in view of the following remarks.

Claims 21-44 remain pending.

I. Claim rejections

Claims 28, 31, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Richard Catalog, IMPEX Can America, Catalog E-40, 1991-1992 (Richard) in view of US Patent 4,969,231 to Mader et al. (Mader).

Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard and Mader, and further in view of US 4,936,170 to Zumeta.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richard and Mader, and further in view of Goodell, Inc. 1993 Catalog, 693-1, p. 2-4, 7 (Goodell).

Claims 21-23, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard in view of Mader and Zumeta.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richard, Mader, and Zumeta, further in view of US 6,295,830 to Bruschi.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richard, Mader, and Zumeta, further in view of Goodell.

Claims 35, 38 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard in view of Mader and Bruschi.

Claims 36, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard, Mader and Bruschi, further in view of Zumeta.

Applicant respectfully traverses each rejection.

A. Background law

In considering obviousness, references may not be combined unless there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to make the combination, and that would also suggest a reasonable likelihood of success. Smiths Indus. Med. Sys. v. Vital Signs, Inc., 183 F.3d 1347, 1356 (Fed. Cir. 1999). The mere possibility that references could be combined is insufficient to support a conclusion of obviousness. Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1478 (Fed. Cir. 1998). Consequently, there is no

legal basis for concluding that an invention would have been obvious "solely because it is a combination of elements that were known in the art at the time of the invention." Smiths Indus. Med. Sys., 183 F.3d at 1356.

It is error to "use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Ecolochem, Inc. v. Southern Cal. Edison Co., 227 F.3d 1361, 1371 (Fed. Cir. 2000). To prevent hindsight-based obviousness analysis, a showing of a teaching or motivation to combine the prior art references is required. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence of motivation to combine references. Ecolochem, 227 F.3d at 1372.

B. Applicant's disclosed invention

The disclosed invention relates to a bladed tool, for example a putty knife, where the handle is provided with color to indicate the flexibility of the blade. A problem with some putty knives is that the knives look very similar to one another, even though the blades may have differing flexibilities and are intended for differing tasks. See, e.g., page 1, lines 11-23. This forces a potential purchaser to inspect the putty knife very closely before purchase to ensure that the correct knife with the correct blade flexibility needed for the task to be performed by the purchaser is selected. See, e.g., page 2, lines 2-5.

If the purchaser lacks familiarity with putty knives and the differences between various putty knives, the incorrect knife may be purchased for the required task. This problem is increasing as a result of the increasing number of homeowners and other do-it-yourselfers who are purchasing putty knives for home repair and home maintenance projects, who may have minimal or no prior experience with such tools. Even if the correct putty knife is purchased, it may have taken the purchaser a significant amount of time to determine which is the appropriate knife to purchase.

The disclosed invention facilitates selection of the proper putty knives by purchasers and other users of putty knives.

C. Long History Of Color Coding

There is a long history of color coding involving a variety of tools to make it easier for a user to identify a particular tool to be used. The information that has been made of record in this case documents the use of color coding of tools for identification purposes all the way back to December 1934 with US Patent 1,984,839. The use of color coding continues to this day, as evidenced by some of the newer documents made of record in this application, for example US Patent 6,195,830 and the cited publications.

Color coding has been used to provide a wide variety of messages to a user of the tool, including the following:

- a) identifying the type of tool (see, e.g. US 1,984,839 and US 4,321,040);
- b) identifying the size of the tool (see, e.g., US 4,321,040 and US 4,936,170);
- c) identifying the name/initials of the tool owner or manufacturer (see, e.g., US 2,187,192);
- d) identifying the function of saw teeth on saw blades (see, e.g., US 3,804,238);
- e) identifying sets of medical instruments (see, e.g., US 4,671,916);
- f) identifying hand tools and small cutting tools belonging to particular sets (see, e.g., US 4,982,627); and
- g) identifying the type of bristle on a paint brush and most suitable paint to be used (see, e.g., US 6,195,830).

It is evident from the information that has been made of record so far in this application that the use of color coding continues to find use in new and ever changing tool areas and for differing tool identification purposes. This is despite the fact that the concept of color coding as applied to tools has been around for decades if not longer.

D. Color Coding Putty Knives And Similar Tools

Even though there has been a long history of color coding tools, and color coding has continued to find use on new tools in the prior art, no one prior to Applicant's earliest filing date, to Applicant's knowledge, has previously utilized color coding on putty knives and similar tools to identify a characteristic of the tool such as blade flexibility. In fact, the long-time standard in the putty knife industry was to indicate blade flexibility using a word, such as "flexible", or

simply a letter, such as "F", to identify the blade flexibility. This flexibility indication was typically provided on the handle and/or on a label attached to the blade.

An example of the industry standard for identifying blade flexibility in putty knives and similar tools is found in the Richard Catalog that has been made of record in this application. As disclosed in the Richard Catalog, the flexibility is indicated by the letter "F" on the handle indicating that the blade flexibility is considered "flexible". This type of flexibility identification was used on the putty knives and similar tools disclosed in this document and by others in the industry for a long period of time despite the long-known use of color coding in other tools.

One problem with using words or other indicia, such as the raised letters in Richard, is that the indicia does not readily stand out relative to other indicia used on similar looking, but differing, knives that may be arranged adjacent to one another in a store display. This complicates user selection of the correct tool, by forcing the user to read the relatively small indicia on each tool. If the potential purchaser is not familiar with the knives disclosed by Richard, and is not aware that there is a difference between the knives disclosed by Richards, the purchaser may simply select one of the knives, including the incorrect knife for the task, without realizing that there is a difference.

Another problem with using words or other indicia, such as the raised letters in Richard, is that the indicia can become worn or obliterated over time through normal use. If this occurs, one cannot tell the flexibility of the blade by simply looking at the tool. As a result, the user must resort to flexing the blade manually in order to gauge its flexibility and from that decide which tool to use.

Color coding has not previously been used to identify blade flexibility. While appearing to be simple at first glance, this use of color coding constitutes a significant advancement in putty knives and similar tools. Purchasers and users of the putty knives and similar tools are now able to easily identify the proper blade flexibility for their needs, both at the time of purchase and after purchase. One reason for this is that color coding is more readily discernible to purchasers and users than the previous industry standard of using lettering, because the color "stands out" and "catches the eye" more than the lettering.

This increased visibility with respect to purchases is illustrated in Exhibit A submitted herewith. As a potential purchaser approaches a display containing similar looking knives, the presence of the differing colors on the knives informs the potential purchaser that there is a

difference between the knives so that the purchaser can investigate further to select the correct knife.

E. Industry Reaction to Color Coded Putty Knives and Similar Tools

One indication of the significance, and non-obviousness, of the use of color coding to indicate blade flexibility in putty knives and similar tools is how the putty knife industry and others have reacted to the introduction of such a color coding scheme.

Exhibits B and C submitted herewith provide an indication of how color coding on putty knives and similar tools has been received since its introduction. Exhibit B shows industry recognition of putty knives incorporating Applicant's disclosed color coding scheme, in which the putty knives received the American Painting Contractor Editor's Choice 2000 Award for being one of that years best tools. Exhibit C is from a newspaper article which describes the color coding as being designed so "each tool is easy to select at a glance for the proper job".

In addition, in November 2001, the use of color to identify tool categories was noted as a "noticeable trend" in the tool market, which would include putty knives and similar tools. (See enclosed Exhibit D from Paint & Decorating Retailer, vol. 38, no. 11, pg. 50, November 2001). It is worth mentioning that this statement concerning a noticeable trend came almost two years after Applicant's earliest filing date, which suggests how significantly Applicant's disclosed color coding scheme has impacted this segment of the tool market.

Enclosed Exhibits E-G are letters received by the assignee, Warner manufacturing Company, from customers of Warner. The letters have been redacted to remove the names and identifying information of the customers. The letters indicate how well received the invention has been, with at least one of Warner's customers having changed an entire product lines in favor of Warner's color coded putty knives.

Another indication of the significance, and non-obviousness, of the use of color coding to indicate blade flexibility in putty knives and similar tools is copying of the color coding scheme by others in the industry. See, e.g., MPEP 716.06. Applicant is aware of at least one other company, Red Devil Inc., that started using color coding to indicate blade flexibility in putty knives after Applicant's earliest filing date and after Applicant's introduction of the disclosed color coding scheme into the market (See enclosed Exhibit H from Paint & Decorating Retailer, vol. 38, no. 11, pg. 43, November 2001). The copying continues to this day.

F. Claims 21-27

Independent claim 21 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Richard in view of Mader and Zumeta. Claims 22-27 depend from claim 21. If claim 21 is found patentable, then claims 22-27 are patentable along with claim 21.

Richard, Mader and Zumeta do not teach or suggest a color coded identification system for identifying a putty knife having a handle and a blade, where the system includes a chart, a handle having a color chosen from the first group of colors on the chart, a blade connected to the handle having the flexibility indicated by the color on the handle, and a label on the blade having an icon illustrating a portion of a putty knife in the same color as the color on the handle.

Richard is relied upon to teach a putty knife with indicia (in the form of a letter) indicating blade flexibility. Mader, which is directed to nut drivers and screw drivers, is relied upon to teach the use of color on a handle to indicate an "operating characteristic". Zumeta is relied upon to teach a chart as claimed.

Richard, Mader and Zumeta do not teach or suggest the use of color on a handle of a putty knife to indicate blade flexibility. The Examiner is picking and choosing among a number of references to arrive at the claimed invention. The color used in Mader does not indicate blade flexibility. As a result, there is no teaching or suggestion as to why one would use color coding in place of the letter used in Richard. The only such teaching comes from Applicant's own disclosure, which is impermissible hindsight.

Nor do these references teach or suggest a chart defining flexibility of a blade using a first group of colors. Again, the Examiner is picking and choosing among a number of references to arrive at the claimed invention. The chart in Zumeta indicates tool size. There is no teaching in any of the cited references, including Zumeta, of using a chart to indicate blade flexibility. Again, the only such teaching comes from Applicant's own disclosure, which is impermissible hindsight.

In addition, it appears that Richard is being relied upon to teach a label having an icon illustrating a portion of a putty knife. The rejection cites to a definition of the word "icon", and indicates that the indicia in Richard constitutes an icon illustrating a portion of a putty knife. Applicant traverses.

Richard uses lettering to indicate blade flexibility. Even if this lettering is construed as an icon, which Applicant does not concede, the lettering does not illustrate a portion of a putty

knife. Claim 21 does not simply recite an icon; claim 21 also recites that a portion of a putty knife is illustrated. It is not clear to Applicant how lettering, as used in Richard, in any way illustrates a portion of a putty knife.

In addition, it is acknowledged in the rejection that the three references do not disclose that the illustration of a portion of a putty knife is in the same color as the color on the handle. Yet, this feature is dismissed as being a mere manufacturing choice. Applicant disagrees. Although a large number of colors could be used, using the same color as the color that is used on the handle and used on the chart provides a further readily visible indication that the putty knife has the indicated blade flexibility and makes selection of the correct tool even easier. The conclusion that this feature is a mere manufacturing choice is without support, particularly by any prior art that has been made of record.

These distinctions alone suggest that claim 21 is not obvious in view of the cited references. The patentability of claim 21 is even more apparent when Exhibits B-H discussed above and the continued evolvement of color coding on tools are considered. As mentioned above, there has been a long history of the use of color coding. Yet, as evidenced by Exhibits B-G, when Applicant introduced this color coding concept, the invention was received with much accolade despite the long history of color coding. Further, as evidenced by Exhibit H, once Applicant's invention became known, at least one competitor started copying substantial aspects of the invention.

Claim 21 is patentable over Richard, Mader and Zumeta, and withdrawal of the rejection is requested. Claims 22-27 depend from claim 21 and are patentable along with claim 21 and need not be separately distinguished at this time. By not separately addressing claims 22-27, Applicant does not concede the propriety of the rejections thereto, and Applicant reserves the right to file arguments at a later date, including on appeal, specifically addressing the dependent claims.

G. Claims 28-34

Independent claim 28 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Richard in view of Mader. Claims 29-34 depend from claim 28. If claim 28 is found patentable, then claims 29-34 are patentable along with claim 28.

Richard and Mader do not teach or suggest a color coded identification system for identifying a hand tool having a handle and an operative member, where the operative member is a blade, and the handle includes a first color chosen from a first group of colors indicating blade flexibility.

Richard is relied upon to teach a hand tool with indicia (in the form of a letter) indicating blade flexibility. Mader, which is directed to nut drivers and screw drivers, is relied upon to teach the user of color on a handle to indicate an "operating characteristic".

Richard and Mader do not teach or suggest the use of color on a handle of a hand tool to indicate blade flexibility. The Examiner is picking and choosing among a number of references to arrive at the claimed invention. The color used in Mader does not indicate blade flexibility. As a result, there is no teaching or suggestion in Richard or Mader as to why one would use color coding in place of the letter used in Richard to indicate blade flexibility. The only such teaching comes from Applicant's own disclosure, which is impermissible hindsight.

These distinctions alone suggest that claim 28 is not obvious in view of the cited references. The patentability of claim 28 is even more apparent when Exhibits B-H discussed above and the continued evolution of color coding on tools is considered. As mentioned above, there has been a long history of the use of color coding. Yet, as evidenced by Exhibits B-G, when Applicant introduced this color coding concept, the invention was received with much accolade despite the long history of color coding. Further, as evidenced by Exhibit H, once Applicant's invention became known, at least one competitor started copying substantial aspects of the invention.

Claim 28 is patentable over Richard and Mader, and withdrawal of the rejection is requested. Claims 29-34 depend from claim 28 and are patentable along with claim 28 and need not be separately distinguished at this time. By not separately addressing claims 29-34, Applicant does not concede the propriety of the rejections thereto, and Applicant reserves the right to file arguments at a later date, including on appeal, specifically addressing the dependent claims.

H. Claims 35-43

Independent claim 35 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Richard in view of Mader and Bruschi. Claims 36-43 depend from claim 35. If claim 35 is found patentable, then claims 36-43 are patentable along with claim 35.

Richard, Mader and Bruschi do not teach or suggest a color coded identification system for identifying a hand tool having a handle and an operative member, where the operative member is a blade, and the handle includes a first portion with a first color chosen from a first group of colors indicating an operative characteristic of the blade, and a second portion covering the first portion of the handle and having at least one window to show the first portion.

Richard does not teach or suggest the use of color on a handle of a hand tool to indicate an operating characteristic of the blade. Mader discloses color coding, but is directed to a tool that does not include a blade. The Examiner is picking and choosing among a number of references to arrive at the claimed invention. The color used in Mader does not indicate a characteristic of a blade. As a result, there is no teaching or suggestion in Richard or Mader as to why one would use color coding in place of the letter used in Richard to indicate a characteristic of a blade such as blade flexibility. The only such teaching comes from Applicant's own disclosure, which is impermissible hindsight.

Bruschi is relied upon to teach the claimed first and second handle portions. Bruschi teaches a handle of a paint brush with a core 13 and a layer 16 molded around the core. The core 13 and layer 16 have different colors that are chosen at will (column 3, lines 51-54). Bruschi also teaches a second colored layer 17 and a colored tip section 10, separate from the core 13 and layer 16, with the layers 17 and tip 10 being used to indicate the type of bristle used (column 1, lines 25-33).

Bruschi does not teach a second portion with at least one window to show the first portion, where the first portion is colored to indicate an operating characteristic of the operative member, as claimed. The colors of the core 13 and layer 16 have nothing to do with indicating the bristle type. Instead, Bruschi teaches using the layer 17 or the tip 10 to indicate bristle type. Neither the layer 17 or the tip 10 meet the first and second portions recited in claim 35. As a result, there is absolutely no teaching to apply the core 13 and layer 16 of Bruschi to the use of color coding on the handle of Richard. In fact, Bruschi teaches away from Richard in directing

that the color coding to indicate bristle type should be located at or near the tip 10 and be separate from the core 13 and layer 16.

These distinctions alone suggest that claim 35 is not obvious in view of the cited references. The patentability of claim 35 is even more apparent when Exhibits B-H discussed above and the continued evolution of color coding on tools is considered. As mentioned above, there has been a long history of the use of color coding. Yet, as evidenced by Exhibits B-G, when Applicant introduced this color coding concept, the invention was received with much accolade despite the long history of color coding. Further, as evidenced by Exhibit H, once Applicant's invention became known, at least one competitor started copying substantial aspects of the invention.

Claim 35 is patentable over Richard and Mader, and withdrawal of the rejection is requested. Claims 36-43 depend from claim 35 and are patentable along with claim 35 and need not be separately distinguished at this time. By not separately addressing claims 36-43, Applicant does not concede the propriety of the rejections thereto, and Applicant reserves the right to file arguments at a later date, including on appeal, specifically addressing the dependent claims.

I. Claim 44

Independent claim 44 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Richard in view of Mader.

Richard and Mader do not teach or suggest a putty knife having a handle and a blade, where the handle includes a first portion with a color chosen from a first group of colors indicating blade flexibility, and where the blade has the flexibility as indicated by the color on the handle.

Richard is relied upon to teach a putty knife with indicia (in the form of a letter) indicating blade flexibility. Mader, which is directed to nut drivers and screw drivers, is relied upon to teach the user of color on a handle to indicate an "operating characteristic".

Richard and Mader do not teach or suggest the use of color on a handle of a putty knife to indicate blade flexibility. The Examiner is picking and choosing among a number of references to arrive at the claimed invention. The color used in Mader does not indicate blade flexibility. As a result, there is no teaching or suggestion in Richard or Mader as to why one would use color

coding in place of the letter used in Richard to indicate blade flexibility. The only such teaching comes from Applicant's own disclosure, which is impermissible hindsight.

These distinctions alone suggest that claim 44 is not obvious in view of the cited references. The patentability of claim 44 is even more apparent when Exhibits B-H discussed above and the continued evolution of color coding on tools is considered. As mentioned above, there has been a long history of the use of color coding. Yet, as evidenced by Exhibits B-G, when Applicant introduced this color coding concept, the invention was received with much accolade despite the long history of color coding. Further, as evidenced by Exhibit H, once Applicant's invention became known, at least one competitor started copying substantial aspects of the invention.

Claim 44 is patentable over Richard and Mader, and withdrawal of the rejection is requested.

II. Conclusion


With the above remarks, Applicant believes that the claims pending in this patent application are in a condition for allowance. Favorable consideration is respectfully requested in the form of a Notice of Allowance. If any further questions arise, the Examiner is invited to contact Applicant's representative at the number listed below.



Respectfully submitted,

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(612) 332-5300

Dated: November 15, 2004

By: 
James A. Larson
Reg. No. 40,443



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A Review of the Year's Best Tools

by Andrew J. Dwyer

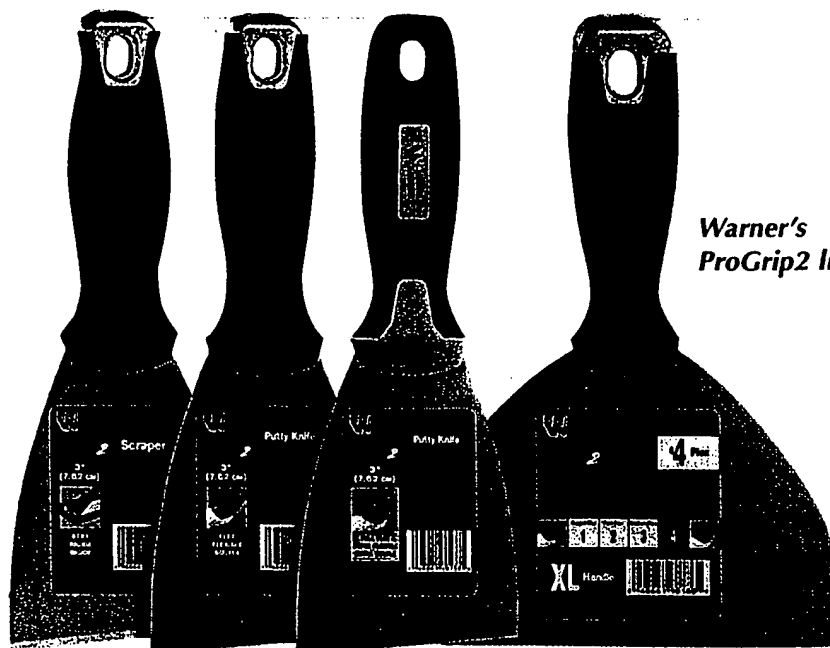
American Painting Contractor is not in the business of testing and reviewing specific products. We are not the *Consumer Reports* of painting. But once a year we select a few tools that deserve your attention. Call it our Holiday Wish List for each of you. Based on personal experience, contractor reviews and our examination of the manufacturer ranks, we have chosen five tools to highlight this year.

Putty Knives

There's nothing sexy about these tools, but they just might be the best putty knives every designed. Warner Manufacturing Co. has established itself as perhaps the finest small tool manufacturer. Last year the company cracked the Editor's Choice Awards with its superior line of paint scrapers (the Carbide 100X line). This year they introduced a superb line of putty knives and scrapers.

The ProGrip2 line consists of an improbable 40 knives to choose from — a mix of blade sizes and flex ratings as well as handle types. For example, Warner's knives are color-coded to match the blade's flex: red for stiff, blue for flex and yellow for full flex. The stiff two-inch putty knife is the finest I've ever held.

More information: Shane Smith, (877) warner-1 or www.warner-tool.com.



Warner's ProGrip2 line

Paint Pump

You might say the 395ST Pro from Graco offers cup-holder appeal — that is, the sprayer does not represent a radical technological innovation, but its design is solid, simple and surprisingly user-friendly. An upgrade of the 395ST, this new model is simply a solid, small- to medium-job sprayer.

Ideal for basic residential jobs — from cabinets to trim — it sprays stains, lacquers, oil base and latex. Give it a test and you'll enjoy its ease of use, thanks to its intelligent design.

Controls are very user friendly — an easy-to-read pressure control knob, easy access filter and even the long on/off switch pleasantly

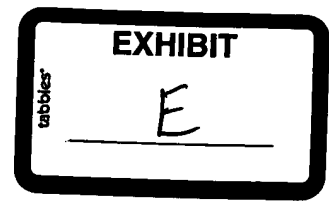


Graco's 395ST Pro Sprayer

surprises. The sprayer features convenient storage of tips, suction tube and throat seal liquid and a

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November 4, 2002

To: Warner Manufacturing
Attn: Jeff Given

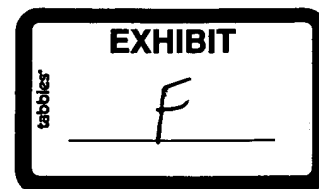
Dear Sir:

Warner Mfg. has done a great job with the current tool program. discontinued all other tool lines and consolidated to Warner Tools. The quality and ease of choice, based on color, has made an impact on sales and service to the customer.

The putty knives and scrapers are color coded so the customer and the sales personnel knows whether it's a stiff blade for scraping (red handle), a flex blade (blue handle) or a full flex blade for finish coats (yellow handle). This color-coded system is one of the main reasons why the buying committee at _____ chose to completely change out all other putty knives and scrapers to Warner Tools.

Thank you,

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November 4, 2002

Mr. William R. Laramy
Director of New Business Development
Warner Manufacturing Company
13435 Industrial Park Blvd.
Minneapolis, MN 55441

Dear Bill:

Just a note to let you know that we are pleased with the presentation of Warner Manufacturing and the Pro-Grip 2 tools in our recently revised training videos. As you have seen, they appear in both the patching and the refinishing videos.

Speaking on behalf of the buying and marketing group, the introduction of Pro-Grip 2 was a great move.

The ergonomic design, and especially the color-coded handles make it easier to sell the right type of tool for the application. We tell people the blue handled Pro-Grip 2 tools (like fluid water) are flexible for applying compounds; and the red tools (like safety red for beware) are stiff and intended for removal. Color-coding was one of the main reasons why we decided to go with Pro-Grip 2 for our member companies and stores.

It's nice to work with a leader and winner. Warner leads the way in the paint & sundries industry with quality tools, great design and constant innovation. Warner continues to be a leader and a winner with

Sincerely,

Director of Marketing, Training & Webmaster

EXHIBIT

G

November 1, 2002

Gary Mueller, *Vice President*
Warner Manufacturing Company
13435 Industrial Park Blvd.
Minneapolis, MN 55441

Dear Gary,

I just wanted to drop you a quick note to let you know the decision for to
switch to Warner Tools has gone very well.

When we did the line review in 2000 with our hand tool category, one of the better
items was the new Pro-Grip 2. We were very impressed with the marketing, the tool
quality and color coded handles.

Thanks for all of your support and help these past couple of years.

Sincerely,

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